REMARKS

These remarks are being submitted in response to the Final Action dated May 12, 2004. Claims 1-7, 9-18, and 20-23 are pending in the present application.

§102 Rejection

The Examiner rejected claims 1 and 12 under 35 USC §102(e) as being anticipated by Wasula (US 2002/0054224). Applicants respectfully disagrees.

In contrast to the present invention, Wasula discloses a system that includes a digital camera, a host processor, and a network service provider. The digital camera includes a database having a plurality of customized profiles. Prior to capturing an image, a user selects one of the customized profiles in the database, and the selected profile is associated with the captured image. The captured image and the corresponding profile are then stored in the camera.

Anticipation requires that the reference teach each and every element of the claims. It is respectfully submitted that Wasula fails to teach and suggest each and every element of the independent claims. For example, Wasula fails to teach or suggest "downloading an action list from the *server* to the image capture device after *the image capture device establishes a connection with the server*," as recited in step (a) of claim 1. Wasula teaches a system that includes " a digital camera 10, a host computer 40, and a network service provider 70 which enables the customization of image organization and transfer of digital images from the digital camera 10 to the host computer 40" (§22). Thus, instead of teaching an image capture device that is capable of communicating directly with a server as claimed, Wasula's digital camera must be connected to PC (rather than a server) and Wasula's PC's is then used to communicate and transfer images to the network server. In addition, Wasula also requires that prior to image

transfer from the digital camera to the host computer, a digital image transfer application program supplied with the digital camera must be uploaded to the hard drive of the host computer (§38). Because the present invention is server-based and the camera is preconfigured to connect directly to the server, the need for a user to upload software to a PC prior to transfer images is eliminated.

Wasula also fails to teach or suggest "displaying the action list to the user on the image capture device *after* the user initiates an image upload process," as recited in step (b) of claim 1. Instead, Wasula teaches that prior to image capture, the user depresses user buttons on the camera user interface to cause a processor to select a "profile selection mode." In this mode, the user then selects a desired profile from a list of existing profiles. Each image capture by the digital camera is then associated with the selected profile (§37). Thus, in the present invention the user selects an action from the action list *after* the user initiates the image upload process and *after* capturing one or more images, whereas in Wasula the user must select a profile *prior* to every image capture.

In the Office Action, The Examiner cites Wasula's host computer saving a new profile table to the camera for teaching the step of "displaying action list to the user on image capture device." However, Applicants donot fully understand this rejection since it is well known that saving a file is not implicitly or explicitly teach or suggest displaying the contents of the file to the user.

Wasula further fails to teach or suggest "after the user selects at least one of the items in the action list, sending the images and the *selected* action list item from the image capture device to the server," as recited in step (c) of claim 1. Applicant agrees that Wasula teaches transferring the profile to the PC. However, instead of transferring a single "selected action list item" from an

action list to the server, Wasula explicitly states that the digital camera sends the "entire profile table" to the image transfer application program running in the host computer (§39). Thus, in the present invention only single item is transferred, which may be a single command, for example to the server, which saves network bandwidth when compared with transferring an entire profile table as taught by Wasula.

Finally, Wasula fails to teach or suggest "performing the action on the uploaded images specified by the selected action item," as recited in step (d) of claim 1. As recited, the images are uploaded to the server and the action is performed on the uploaded images. Thus, it is inherent that the server is performing the action on the uploaded images. In contrast, Wasula teaches that it is the transfer application running on the host computer rather than the network server coupled to the host computer, that performs the actions specified in the utilization fields defined in the profile (§40).

The arguments made above apply with full force and effect to independent claims 12 and 23. Accordingly, because Wasula fails to teach each and every element of the independent claims, Wasula fails to anticipate the present invention under §102.

§103 Rejection

The Examiner rejected claims 1-7, 9-18, and 20-23 under 35 USC §103(a) as being unpatentable over Safai (US 6,167,469) in view of Wasula. The Examiner rejected claims 10-11 and 21-22 under 35 USC §103(a) as being unpatentable over Safai in view of Wasula in view of Steinberg. Applicants respectfully traverse the rejections.

In contrast to the present invention, Safai is directed to a method and apparatus for transporting digital images from a digital camera to a server. The digital camera executes a transport application that enables a user to send one or more pictures from the camera to one or more external addresses (column 7, lines 31-37). When the transport application is launched, a top-level view of the functions available in the transport application is displayed to the user (column 8, lines 21-27). As shown in figure 4A, the functions include selecting address, choosing a photo, recording a voice message, and sending a photo.

In the Final Office Action, Examiner admits that "Safai does not teach the applicant's newly added limitation "downloading an action list from the server to the image capture device after the image capture device establishes a connection with the server." The Examiner cites Wasula for teaching a digital image transfer device that downloads user created profile data in the form of an action list to the digital camera from a host computer. The Examiner stated "it would have been obvious for one skilled in the art to a been motivated to download an action list of Safai from the server or host computer and store it on the digital camera for the advantage of creating customized user profiles on a computer that are storable on a portable digital camera as suggested by Wasula (§27)."

Applicants respectfully submit that the combination of Safai and Wasula fail to render the claims of the present invention obvious for the following reasons: 1) It is respectfully submitted

that Safai is non-analogous art; and 2) due to the technical differences between Safai and Wasula, one of ordinary skill in the art would be unmotivated to combine Safai and Wasula because there would be no reasonable expectation of success.

Safai is Non-Analogous Art

The present invention is a server-side processing architecture, where a selected action is uploaded to the server along with an image and the server performs the action on the image. In contrast, Safai is directed to a standard client-server architecture that is well-known in the art at the time and similar to the prior art discussed in the Background of the present application. In such client-server architecture, application software is required on the client device to process data prior to sending the data to the server. Thus, Safai fails to teach or suggest "A method for allowing a user to select *actions to be taken by a server* when uploading images from a hand-held image capture device, as recited in the present invention, because Safai requires the client to perform some, if not all of, the requested action. That is, the action request is sent to the client side application which begins processing the action. The processing may be completed on the server, but no action request or command is transmitted from the device to the server.

Safai describes that each "action" selected results in an application being launched on the client (i.e., an email application for email, a print application for print, and a camera settings application for settings). This means that for any given "action", Safai requires executable code on the camera specific to the action to fulfill the request. The graphical interface sited by the Examiner includes four actions, two of which, image editing and change camera settings, are traditional client functions only. Safai describes neither or these actions so how they are processed is unknown. The processing of another action, "Print," is unclear since Safai does not

describe it's operation at all. Print function on a camera was not unusual at the time of Safai's application, but the typical print functions are either a direct-to-printer command or through a PC host. Since Safai doesn't describe the print application, it's not clear what role the client and server play. Safai does mention printing in the context of the transport application, but it's merely a mechanism for delivering and image to a postal address and thus part of the transport applications routing function and not a general print feature.

Of the applications displayed on the main menu of the client device, Safai only describes the detailed operation of the "Mail" or transport application. It appears that the Examiner has misinterpreted Safai's mail transport application as the action being performed by the server, when in fact, all the transport application does is route images based on the address and address type. The Mail application clearly requires client side processing, and the mail transport application does not send an action to the server, only photos, addresses, and voice messages. The action to be performed is fixed and implicit. It is hard-coded in the relationship between the client-side code and the server-side code. The server simply routes information based on address type (Col. 14, line 8 through Col. 15 line 11). The other services described by Safai are either initiated after upload time (e.g from a web browser or remotely from the device) or also have a client specific piece and a server specific piece (print).

It is respectfully submitted that the specification of an address, as in Safai, is non-analogous to an action request since routing based on addresses and address type was well-known at the time and similar to the prior art email feature discussed in the Background of the present application. The printing feature referred to by the Examiner in this regard is merely another aspect of the routing function of the transport application. Printing only takes place when an addressee has a mailing address. It is not in this sense an action distinct from the

general routing action performed by the transport application. No print request is sent from the client to the server, merely an address is sent.

Due to the technical differences between Safai's client-side transport application and the server-side processing of present invention, it is respectfully submitted that Safai is non-analogous art and therefore an improper reference for a §103 rejection. It is respectfully submitted that any interpretation of Safai's transport application being analogous to server-side processing would be in error and based on impermissible hindsight.

Safai cannot be combined with Wasula

According to MPEP 706.02(j), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is respectfully submitted that due to the technical differences between Safai and Wasula, one of ordinary skill in the art would be unmotivated to combine Safai and Wasula because there would be no reasonable expectation of success.

It's difficult to imagine combining Safai and Wasula given that Safai is non-analogous, as described above, but also because Safai and Wasula teach away from each other in so many ways. First, similar to the present invention, Wasula is directed to a server-side processing architecture, rather than to Safai's client-side processing (if one assumes for purposes of argument that Wasula's PC performs server side processing). That is, no "action" specific processing occurs on the client device in Wasula. A combination of Safai and Wasula would require that some of Safai's features to be handled by the Wasula's server. However, some of Safai's features would not function if processing was handled on the server. For example, adding

a voice message to an image must be performed on the client. Safai would thus have no motivation for predefining this feature to be performed by a server. Given that Safai's transport application is designed to support only one action at time of upload, namely routing, there is no motivation to use downloadable server-side actions since no flexibility in the choice of actions is required. The Examiner implies that addresses are actions, but the use of addresses limits Safai's system to only routing options. Safai system was not intended to process more than this one type of action, and hence there would be no motivation for downloading actions.

In addition, the purpose of Safai is to allow user's to choose where an image is routed at upload time, whereas the purpose of Wasula is to support unattended upload.

Finally, Safai's actions are fixed in code that is resident on the client and server. Safai supports allowing the user to specify various addresses (not be be confused with "actions"), whereas Wasula profiles are updatable.

Based on such fundamental differences between Safai and Wasula, it is respectfully submitted that a combination of these references is unsupported and is based on improper hindsight.

The arguments above apply with full force and effect to the dependent claims because they are based on allowable independent claims. Therefore the dependent claims are allowable for at least the same reasons as the independent claims.

Based on the foregoing, Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

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Date

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